REMARKS

Claims 1-8 are pending in the application. Claims 10-14 have been withdrawn from consideration in response to the restriction requirement. Claim 1 is amended herein to include the limitation of "a coercive force of 96 A/m or less." Claim 9 is therefore canceled to avoid redundancy. No new matter has been added.

Rejections Under 35 U.S.C. § 103

The Examiner asserted that claims 1 to 9 are unpatentable over Jin et al. ("Jin," U.S. Patent No. 4,536,229) under 35 U.S.C. 103(a). In light of the amendment herein to claim 1, Applicants respectfully disagree.

As amended herein, claim 1 requires a plated soft magnetic film "comprising a coercive force of 96 A/m or less." Jin does not disclose a soft magnetic film comprising a coercive force of 96 A/m or less. In fact, the reference discloses a hard magnetic alloy with a "preferred coercivity [of] greater than or equal to 40 oersteds and preferably greater than or equal to 100 oersteds." Since 1 A/m = 0.01257 oersted,[1] Jin discloses preferred coercive force values of greater than or equal to 3,182 A/m or greater than or equal to 7,955 A/m. These are vastly different values than the coercive force (96 A/m or less) recited in the amended claim.

Further, the Examiner alleged that "the alloy taught by the reference is made by a process which is similar to, if not the same as, Applicants' process of making the instantly claimed alloy," and thus "the alloy taught by the reference would be expected to possess all the same properties as recited in the instant claims." In fact, the alloy of Jin is made by an entirely different process than the soft magnetic film of the present application. As taught in col. 2, lines 31-37 of Jin: "In accordance with the invention, Fe-Ni-Mo alloys suitable for magnet alloys have a so-called aligned microduplex multi-phase structure which is aligned and elongated and which can be produced by thermomechanical processing comprising plastic deformation, heating to produce two-

[1] Z. D. Jastrzebski, *The Nature and Properties of Engineering Materials, 3rd Edition* (John Wiley & Sons 1987).

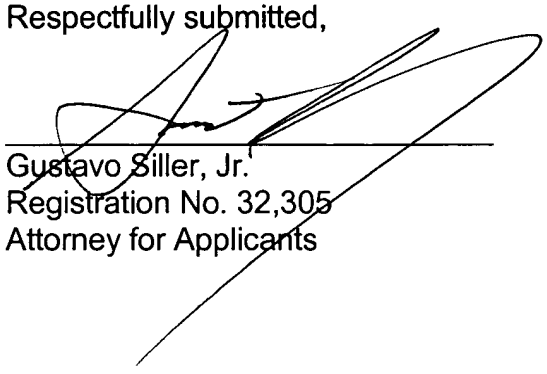
phase decomposition, additional deformation, and final low-temperature precipitation aging." (Emphasis added.) This process yields an alloy having a "deformed microstructure" and a "preferred coercivity [of] greater than or equal to 40 oersteds." (col. 2, lines 62-67) In contrast, Applicants' soft magnetic film is formed by plating, such as, for example, pulse current plating. A description of at least one embodiment of this process may be found in the specification in paragraphs [0147]-[0157]. Clearly, the thermomechanical process of Jin and the plating process of the present application are different. In light of this, the Examiner's argument that "the alloy taught by the reference would be expected to possess all the same properties as recited in the instant claims" is groundless.

Since Jin does not teach or suggest each and every element of claim 1, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the rejection of claims 1-8 under 35 U.S.C. § 103(a) be withdrawn.

Summary

Applicants believe that currently pending claims 1-8 are in condition for allowance. The Examiner is invited to contact the undersigned attorney for the Applicants via telephone if such communication would expedite allowance of this application.

Respectfully submitted,



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